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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,109	05/24/2001	Heinrich Pajunk	71049	3047
22242	7590	02/24/2004		
FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			EXAMINER ROBERT, EDUARDO C	
			ART UNIT 3732	PAPER NUMBER 13

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,109

Applicant(s)

PAJUNK ET AL.

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-12,14-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-12,14-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 7-12, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kokernak.

Kokernak discloses an apparatus comprising a housing 10 having cylinder 14; a piston, e.g. 20, arranged in a longitudinally displaceable manner in the cylinder (see Figures 1 and 4); an exit aperture 16 formed in the cylinder; a screw movement (see Figures 1, 2, and 3); and an arrangement (see Figures 2 and 3). The piston has an engaging sections or threads that engages into a cooperating toothed arrangement or threads 49 provided at the housing 10 such that the longitudinal displacement of the piston is effected when the engaging section is turned (see col. 3, lines 11-14). The engagement is done by biasing of the toothed arrangement with the engaging sections of the piston. The engaging section or threads and the cooperating toothed arrangement or threads 49 can be uncoupled (see col. 3, lines 11-14 and Figures 1-3). The cooperating toothed arrangement or threads 49 can be moved in a direction substantially perpendicular to the direction of displacement of the piston. The piston can be longitudinally displaced in a substantially free manner in the cylinder when uncoupled. The piston and engaging section are formed as one piece (see Figure 4). A cannula can be fastened to the exit aperture is so desired.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kokernak in view of Jacoby, Jr. (Reference U.S. Pat. No. 2,711,733 on PTO-1449).

Kokernak discloses the claimed invention except for the system having a cannula with an aperture and a coupling section. Kokernak discloses that a cannula or catheter can be attached for injecting fluid and Jacoby, Jr. discloses a cannula or catheter for injecting fluid. It would have been obvious to one skilled in the art at the time the invention was made to provide the apparatus of Kokernak with a cannula or catheter in view of Jacoby, Jr., in order to inject a fluid. It is noted that any cannula or catheter could be adapted for connection with the apparatus of Kokernak for the purpose of injecting a fluid.

Response to Arguments

Applicant's arguments filed on December 4, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that Kokernak does not disclose a bias, it is noted that claim 1 states "said piston comprises an engaging section having a screw thread that engages a cooperating toothed arrangement under bias provided at the housing ..." and Kokernak shows that a piston, e.g. 20, having screw thread and a toothed arrangement or threads 49 and the

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threads of the piston and toothed arrangement or threads 49 engages with each other under bias, i.e. biasing the toothed arrangement or threads 49 to engage the threads of the piston. at the housing.

In response to applicant's argument that Kokernak is not used and does not address the same problems of applicant, it is noted that the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In response to Applicant's argument that there is no suggestion to combine the references (Kokernak in view of Jacoby, Jr.), the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In *re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In *re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In *re Bozek*, 163 USPQ 545 (CCPA) 1969. In this case, Kokernak discloses that a cannula or catheter can be attached to the system for injecting fluid (see for example col. 2, lines 36-40), however, Kokernak does not disclose the specifics of the cannula or catheter, e.g. a cannula with an aperture and a coupling section.

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Jacoby, Jr. disclose a cannula or catheter for the purposes of injection fluid. Thus, it is clear that it would have been obvious to one skill in the art at the time the invention was made to provide the apparatus of Kokernak with a cannula or catheter in view of Jacoby, Jr., for the purposes of injecting fluid, i.e. the motivation to do so.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

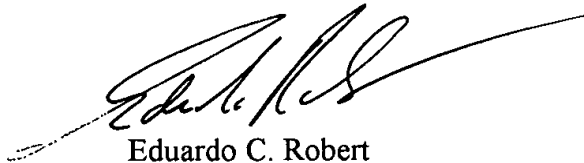
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Eduardo C. Robert', with a long horizontal flourish extending to the right.

Eduardo C. Robert
Primary Examiner
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E.C.R.